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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,084	02/03/2006	Kazuhiro Yanagisawa	Q92943	2328
<div>23373 7590 09/05/2007</div> <div>SUGHRUE MION, PLLC</div> <div>2100 PENNSYLVANIA AVENUE, N.W.</div> <div>SUITE 800</div> <div>WASHINGTON, DC 20037</div>				
			<div>EXAMINER</div> <div>SCOTT, ANGELA C</div>	
			<div>ART UNIT</div> <div>1709</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE</div> <div>09/05/2007</div>	<div>DELIVERY MODE</div> <div>PAPER</div>

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/595,084

Applicant(s)

YANAGISAWA ET AL.

Examiner

Angela C. Scott

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 02/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112 and §101

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10-11 provide for the use of the rubber composition of claim 9 in either a tire or a belt, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 10-11 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for

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example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagisawa et al. (US 2003/0088006).

Regarding claim 1, Yanagisawa et al. teaches a method for producing a rubber master batch comprising the step of mixing a rubber latex (rubber solution) with a slurry of a filler dispersed into water (¶19).

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Yanagisawa et al. does not teach that the mixing of the rubber solution and the slurry solution takes place in either a static mixer or a high shear mixer comprising a rotor and a stator portion. However, Yanagisawa et al. does teach that the aqueous slurry of the filler is prepared by using a high-shear mixer of rotor-stator type (§36). At the time of the invention, a person of ordinary skill in the art would have found it obvious to use a high-shear mixer of rotor-stator type to mix not only the slurry solution, as taught by Yanagisawa et al., but the rubber solution and the slurry solution together, and would have been motivated to do so in order to simplify the process by only having to use one type of mixer.

Regarding claim 2, Yanagisawa et al. additionally teaches that the filler is selected from the group consisting of carbon black, silica, and an inorganic filler represented by the following formula:



wherein M_1 is at least one member selected from the group consisting of metals of aluminum, magnesium, titanium, calcium or zirconium, oxides of the preceding metals, hydroxides of the preceding metals, hydrates of the preceding oxides and hydroxides, and carbonates of the preceding metals; n is an integer of 1 to 5, x is an integer of 0 to 10, y is an integer of 2 to 5, and z is an integer of 0 to 10 (§§13-14).

Regarding claims 3 and 4, Yanagisawa et al. additionally teaches that the rubber solution is a natural rubber latex (§19).

Regarding claim 5, Yanagisawa et al. additionally teaches that the amide linkages in the natural rubber latex are cleaved with a protease (§§19 and 21).

Regarding claim 6, Yanagisawa et al. additionally teaches when the natural rubber latex (rubber solution) is mixed with the slurry solution, the mixture is coagulated (§42) and has a water content of preferably 10% or more (§45) and then the mixture is dried by applying a mechanical shearing force (§44).

Regarding claim 7, Yanagisawa et al. additionally teaches that the drying under shear force can be carried out by using a known kneader, preferably by a continuous kneader in view of industrial productivity. More preferably, a corotating or counterrotating twin-screw kneading extruder is used (a screw-type continuous milling machine) (§44).

Regarding claim 8, Yanagisawa et al. additionally teaches a natural rubber master batch obtained by the above methods (§46).

Regarding claim 9, Yanagisawa et al. additionally teaches a natural rubber composition prepared by using the natural rubber master batch (§47).

Regarding claims 10 and 11, Yanagisawa et al. additionally teaches that the rubber composition is applicable to tire applications as well as belts (§115).


Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela C. Scott whose telephone number is (571) 274-3303. The examiner can normally be reached on Monday through Friday, 7:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ACS 
August 28, 2007


MARK EASHOO, PH.D.
SUPERVISORY PATENT EXAMINER

30 / Aug / 07